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Trans. Let and Petition for Review of
Restriction Requirement

Applicant(s): **Daniel A. Gately**

Title: **Silylated and N-Silylated Compound Synthesis**

Serial No.: **09/016,641**

Filing Date: **1/30/98**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
DANIEL ANTHONY GATELY : Art Unit 1621
Filed: January 30, 1998 :
Serial No.: 09/016,641 : Examiner: J. Vollano
FOR: SILYLATED AND N-SILYLATED :
COMPOUND SYNTHESIS :
:

TRANSMITTAL OF
PETITION TO REVIEW RESTRICTION REQUIREMENT

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Transmitted herewith is a "Petition to Review Restriction Requirement" under 37 C.F.R. §1.144. No fee is believed to be due. However, if it is determined that a fee for filing is required, such fee may be charged to Deposit Account 09-0948. A duplicate is attached.



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Dated: May 28, 1999

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Honorable Commissioner of
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Sir:

PETITION

Pursuant to 37 C.F.R. §1.144, this petition requests the Commissioner to review the final requirement for restriction mailed March 25, 1999. Reconsideration of the original restriction requirement was requested, but did not result in any change upon entry of the final requirement.

STATEMENT OF FACTS

The Request for Reconsideration filed January 14, 1999 includes Reasons 1, 2(a) and (b), and 3. The Examiner's Response does not address these reasons separately. Instead, the Response is generalized and lacks clarity in the context of the specific Reasons 1, 2(a) and (b), and 3 as set forth in the Request for Reconsideration.

Reason 1

Applicant's Reason 1 states:

1. Each of the examiner's "inventions" I-IV purport to be based on portions of claims, e.g., "Claims 1-3 (in part)" (examiner's invention "I"). Pursuant to 35 U.S.C. §103(a), claimed inventions are to be considered and acted upon by the examiner "as a whole". The restriction requirement cites no authority, rule or regulation for predicating restriction only on a "part" of a claim. For that reason alone, each of the examiner's purported inventions "I-IV" is inappropriate. Therefore, the restriction requirements as between or among any of the examiner's not the number of claims that are [sic] used when restricting the application. (p. 9)

The Examiner makes only a conclusory and generalized response which, of course, is not a sound basis for the required restriction. Apparently, the sole relevant statement by the Examiner is made only in the context of the Examiner's Group III and IV, i.e.:

Applicant...has only stated that it is inappropriate and wrong to restrict within a claim. If there are multiple inventions in a claim the claim can be restricted into the different inventions. It is the number of inventions not the number of claims that are [sic] used when restricting an application.... (action, p. 9)

This Examiner's ipse dixit is improvident.

As noted in the Request for Reconsideration: "Pursuant to 35 U.S.C. §103(a), claimed inventions are to be considered and acted upon by the examiner 'as a whole'" (emphasis added). (A

claimed invention is unpatentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious..."; 35 U.S.C. §103(a).) Under 35 U.S.C. §121 (1994): "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions".

The word "invention" must have the same meaning in §103(a) and §121 of Title 35. Therefore, the word "invention" in §121 must mean the claimed "subject matter as a whole", just as in §103(a). For that reason, it is indeed "inappropriate...to restrict within a claim" (action, p. 9).

Further, the Examiner's notion that there may be "multiple inventions in a claim" which therefore "can be restricted into the different inventions" (id) clashes not only with §103(a) but also with §112. If such a restriction were permitted, it would force the applicant to fragment the claimed "subject matter as a whole" into a plurality of claims, none of which actually "point[s] out and distinctly claim[s] the subject matter [as a whole] that the applicant regards as his invention or discovery". 35 U.S.C. §112; 37 C.F.R. §1.75(a).

Reason 1 of the Request for Reconsideration is maintained.

Applicant's Reason 2(a) states:

2. The restriction requirement is illogical and inconsistent in the following respects:

(a) The examiner's invention "I" includes "Claims 1-3(in part) and 4"; whereas, the examiner's invention "II" includes "Claims 1-3(in part), 5-6 and 14-15". If, as the examiner's invention "I" admits, claim 4 can properly be examined with claims 1-3, then claim 4 can properly be examined in connection with claims 1-3, 5-6 and 14-15 which comprise the examiner's invention "II".

The assertion in paragraph 2 of the restriction requirement that inventions "I" and "II" are "unrelated" is contradicted by the fact that "Claims 1-3(in part)" are included in each of inventions "I" and "II".

Inventions "I" and "II" should be combined to yield a single "invention".

Applicant maintains the position that, at a minimum, "Inventions 'I' and 'II' should be combined". To argue otherwise, the Examiner states:

Applicant states that the Examiner's invention I includes claims 1-3 (in part) and 4 and invention II includes claims 1-3 in part and claims 5-6 and 14-15. This is correct. Applicant further states that "If as the examiner's invention I admits, claim 4 can properly be examined with claims 1-3 then claim 4 can properly be examined with...the examiner's Invention "II".

Claim 4 is a species claim to the genus found in group I and has been placed in that group as such. It does not contain an amine group. It is not a basic compound and it is not related to the compounds of Group II. Claims 1-3 are generic claims which encompass two different structural types of compounds amine compounds and compounds which do not contain an amine moiety. [sic] The compounds have different properties chemical and physical and different reactivities. The amines are basic compounds in which the hydrogen on the

nitrogen can be replaced with various functional groups. The solvent systems need for the reactions of Group II must be used in view of the chemical reactivity and basic nature of the amine (for example if an acidic medium, such as sulfuric acid, was used in a reaction the sulfate salt would form and precipitate). The compounds of invention I are different from the compounds of invention II and have different effects for the reasons stated above as well as the reasons stated in the restriction of 1/7/99. (p. 8)

This argument is not persuasive for at least three reasons:

(i) It includes an aberrant restriction within a claim ("Claim 3, in part").

(ii) It evades and so tacitly concedes, applicant's common sense point that:

If, as the examiner's invention "I" admits, claim 4 can properly be examined with claims 1-3, then claim 4 can properly be examined in connection with claims 1-3, 5-6 and 14-15 which comprise the examiner's invention "II".

(iii) It is based solely on mere examiner ipse dixit; not on any reference or other evidence regarding the structural types of compounds involved, the chemistry in which (according to the Examiner) the various compounds may implicate, "solvent systems" which may be involved, etc.

None of this undocumented Examiner speculation justifies the illogic in the proposed restriction between Invention I and Invention II.

Applicant maintains the position set forth in Reason 2(a) of the Request for Reconsideration.

Applicant is not required to respond and so does not respond to the examiner's "obvious variants" query.

Applicant's Reason 2(b) states:

2. The restriction requirement is illogical and inconsistent in the following respects:

(b) The examiner's invention "III" includes only "Claim 7(in part)"; whereas, examiner's invention "IV" includes "Claims 7(in part) and 8". If claim 8 is properly examined with "Claim 7(in part)", the restriction between the examiner's inventions "III" and "IV" is inappropriate for the same reason that the requirement for restriction between inventions "I" and "II" is wrong.

The Examiner falls back on "reasons stated in the restriction of 1/7/99" which, she says, applicant has not addressed other than to note the manifest error of an attempt "to restrict within a claim". Because it is incorrect to restrict within a claim, any restriction between Invention III and Invention IV must be withdrawn, without more.

Because there is no evidence of record so demonstrating the last sentence ("materially different process...") of each of paragraphs 3 and 4 of "restriction of 1/7/99", the requirement for restriction is unsupported and invalid.

Applicant maintains reason 2(b).

Applicant's Reason 3 states:

3. Referring to paragraph 5 of the restriction requirement, the assertion that "Inventions III, IV and V are unrelated" contradicts the text of the claims which comprises these "inventions". Claim 7 defines "[a] method for preparing a silylated or N-silylated mono- or bis-cyclopentadienyl or indenyl compound". Claim 8 is limited to a method of preparing a species of the same N-silylated compound defined by claim 7. Note in this regard that the compound of claim 6 referenced in claim 8 is a species of a claim 1 compound; whereas, claim 7 also specifies a compound of claim 1 (ll. 4-5).

The reference to claim 7 in line 4 of claim 8 is inappropriate and has been cancelled by this response.

As appears from the text of claims 7 and 8, the assertion in paragraph 5 of the restriction requirement that "invention III is a method of preparing organosilyl [sic] aromatic compounds wherein invention IV forms nitrogen silyl compounds with different chemical and physical properties" is incorrect. Both claim 7 (invention "III") and claim 8 (invention "IV") are methods for preparing organosilyl compounds including nitrogen silyl compounds. The examiner has cited no evidence and can cite no evidence to justify the fact-finding that the invention "III" and "IV" compounds are distinguished in any way which justifies the restriction requirement between "Claim 7(in part)" (invention "III") and the same claim 7 (in part) together with claim 8 (invention "IV").

The examiner does not address this Reason 3. It is understood, therefore, that the Examiner agrees that her "assertion that 'Inventions III, IV and V are unrelated' contradicts the text of the claims", wherefore, paragraph 5 of the January 7, 1999 restriction is wrong. It needs to be withdrawn or overruled.

Further, paragraph 5 of the January 7, 1999 restriction is, again, just an argument based on the Examiner's view—unsupported by any evidence of record—of the "chemical and physical properties" of some of the compounds she finds it useful to include in the various "inventions" set forth in the January 7, 1999 restriction requirement.

The Examiner's statement that applicant has made no comment on Group V (p. 9) is incorrect for two reasons.

First, applicant's Reason 3 specifically addresses "Inventions III, IV and V".

Second, applicant provisionally elected the Examiner's Invention V (Request for Reconsideration, p. 1).

RELIEF REQUESTED

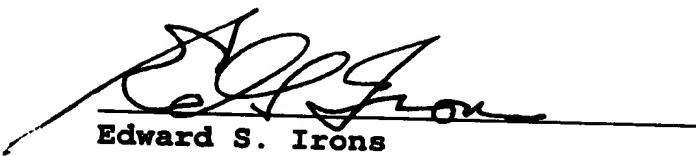
It is requested that:

- (1) The restriction requirements as between or among any of the Examiner's Inventions I to V be withdrawn.
- (2) If Request (1) is denied, it is requested that Inventions I and II be combined into a single invention which includes claims 1-7 and 14-15 and that the Examiner's Inventions III, IV and V be

combined into a single invention that includes claims
9-15.

CONCLUSION

This Petition should be granted for the reasons stated.



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